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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/707,612	12/24/2003	Daniel W. Cushing	03-1090	1611

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EXAMINER

PIZIALI, ANDREW T

ART UNIT	PAPER NUMBER
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1794

NOTIFICATION DATE	DELIVERY MODE
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01/04/2010

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ptonotifs@yeeiplaw.com

Office Action Summary	Application No. 10/707,612	Applicant(s) CUSHING ET AL.	
	Examiner Andrew T. Piziali	Art Unit 1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 October 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-18,40 and 41 is/are pending in the application.
- 4a) Of the above claim(s) 6-18 and 40 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4,5 and 41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12/24/03 & 11/9/05 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

BPAI Decision

1. On 8/18/2009 the Board of Patent Appeals and Interferences ruled that "Boeing is not entitled to a patent containing claims 1-2 and 4-5." The Board of Patent Appeals and Interferences **AFFIRMED** the rejection of all pending claims.

Response to Amendment

2. In response to the examiner being **AFFIRMED** by the BPAI, applicants filed an amendment on 10/19/2009. Said amendment has been entered.

Claim Rejections - 35 USC § 102/103

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 2, 4, 5 and 41 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over USPN 5,911,932 to Dyksterhouse.

Art Unit: 1794

Dyksterhouse discloses a two-layer composite material comprising: a substantially continuous nonwoven, non-fabric, thermoplastic polyphenylsulfone substrate; and a plurality of long s-type or e-type glass fibers laminated within the polyphenylsulfone substrate (see entire document including column 3, lines 25-48, column 4, line 62 through column 5, line 30, and column 7, lines 34-55).

Considering that the composite taught by Dyksterhouse is substantially identical to the claimed composite in terms of a polyphenylsulfone substrate material and long e-type or s-type glass fibers, it appears that the structure taught by the applied prior art inherently possesses the claimed characteristics and properties.

The Patent and Trademark Office can require applicants to prove that prior art products do not necessarily or inherently possess characteristics of claimed products where claimed and prior art products are identical or substantially identical, or are produced by identical or substantially identical processes; burden of proof is on applicants where rejection based on inherency under 35 U.S.C. § 102 or on prima facie obviousness under 35 U.S.C. § 103, jointly or alternatively, and Patent and Trademark Office's inability to manufacture products or to obtain and compare prior art products evidences fairness of this rejection, *In re Best, Bolton, and Shaw*, 195 USPQ 431 (CCPA 1977).

Regarding claim 2, Dyksterhouse discloses that fibers may comprise a plurality of unidirectional fibers (column 7, lines 34-45).

Regarding claims 4 and 5, Dyksterhouse discloses that the composite material may comprise a component of an aircraft (column 1, lines 14-28).

Art Unit: 1794

Regarding claim 41, Dyksterhouse discloses that the composite is formed by an impregnation process (column 8, lines 1-15). Absent a showing to the contrary, it is the examiner's position that the article of the applied prior art is identical to or only slightly different than the claimed article. Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985). The burden has been shifted to the applicant to show an unobvious difference between the claimed product and the prior art product. *In re Marosi*, 218 USPQ 289 (Fed. Cir. 1983). The applied prior art either anticipated or strongly suggested the claimed subject matter. It is noted that if the applicant intends to rely on Examples in the specification or in a submitted declaration to show non-obviousness, the applicant should clearly state how the Examples of the present invention are commensurate in scope with the claims and how the Comparative Examples are commensurate in scope with the applied prior art.

Claim Rejections - 35 USC § 103

6. Claims 1, 2, 4, 5 and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 4,966,801 to Becker in view of any one of USPN 5,911,932 to Dyksterhouse or USPN 5,319,003 to Gomez.

Becker discloses a two-layer composite material comprising: a substantially continuous nonwoven, non-fabric, thermoplastic polyphenylsulfone substrate; and a plurality of long glass fibers having a melting temperature above the melting temperature of the polyphenylsulfone and

Art Unit: 1794

laminated within the polyphenylsulfone substrate (see entire document including column 1, line 65 through column 2, line 25, column 3, lines 8-22, column 4, line 57 through column 5, line 32, column 7, lines 13-36, and column 8, lines 25-34). Becker discloses that the substrate material may be bonded to one side of the fibers (column 8, lines 25-34).

Becker discloses that the glass fibrous material may be silicate or non-silicate glass, but Becker is silent with regards to specific silicate glass material. Therefore, it would have been obvious to look to the prior art for conventional silicate glass fibers. Dyksterhouse and Gomez each provide this conventional teaching showing that it is known in the resin/fiber composite art to use s-type or e-type glass fibers (see entire documents including column 3, lines 39-48 of Dyksterhouse and column 2, lines 60-68 and column 3, lines 28-31 of Gomez). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to make the glass fibers from s-type or e-type glass fibers, motivated by the expectation of successfully practicing the invention of Becker.

Considering that the composite taught by the applied prior art is substantially identical to the claimed composite in terms of a polyphenylsulfone substrate material and long e-type or s-type glass fibers, it appears that the structure taught by the applied prior art inherently possesses the claimed characteristics and properties.

The Patent and Trademark Office can require applicants to prove that prior art products do not necessarily or inherently possess characteristics of claimed products where claimed and prior art products are identical or substantially identical, or are produced by identical or substantially identical processes; burden of proof is on applicants where rejection based on inherency under 35 U.S.C. § 102 or on prima facie obviousness under 35 U.S.C. § 103, jointly

Art Unit: 1794

or alternatively, and Patent and Trademark Office's inability to manufacture products or to obtain and compare prior art products evidences fairness of this rejection, *In re Best, Bolton, and Shaw*, 195 USPQ 431 (CCPA 1977).

Regarding claim 2, Becker discloses that fibers may comprise a plurality of unidirectional fibers (column 1, lines 13-19 and column 3, lines 8-22).

Regarding claims 4 and 5, Becker discloses that the composite material may comprise a flat or curved component of an aircraft (column 9, line 59 through column 10, line 21).

Regarding claim 41, Becker discloses that the composite is formed by an impregnation process (column 8, lines 14-34). Absent a showing to the contrary, it is the examiner's position that the article of the applied prior art is identical to or only slightly different than the claimed article. Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985). The burden has been shifted to the applicant to show an unobvious difference between the claimed product and the prior art product. *In re Marosi*, 218 USPQ 289 (Fed. Cir. 1983). The applied prior art either anticipated or strongly suggested the claimed subject matter. It is noted that if the applicant intends to rely on Examples in the specification or in a submitted declaration to show non-obviousness, the applicant should clearly state how the Examples of the present invention are commensurate in scope with the claims and how the Comparative Examples are commensurate in scope with the applied prior art.

Response to Arguments

7. Applicant's arguments filed 10/19/2009 have been considered but are moot in view of the new grounds of rejection.

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew T. Piziali whose telephone number is (571) 272-1541. The examiner can normally be reached on Monday-Friday (8:00-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Larry Tarazano can be reached on (571) 272-1515. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Andrew T Piziali/
Primary Examiner, Art Unit 1794